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DATE: June 14, 2002

RECIPIENT INFORMATION	SENDER INFORMATION
To: Examiner M. Trinh	From: Rosemary Riccard for James A. LaBarre
Voice Tel. No.: 703 305 2887	Voice Tel. No.: 703 836 6620
Fax Tel. No.: 703 308 7058	Sent By: Rosemary
Your Ref.: USSN 09/545,288	Our Ref.: 032326-057
	Total Pages (Incl. Cover Page): Five (5)

**RE:** U.S. Patent Application Serial No. 09/545,288 for "Method for Making Smart Cards Capable of Operating With and Without Contact"; Inventor: Stephane AYALA et al**MESSAGE:**

Transmitted herewith please find a copy of a Response which was filed in the U.S. Patent and Trademark Office on November 27, 2001 and a copy of the stamped postcard receipt. Please let us know if we can be of any further assistance in this regard.

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GROUP 3700

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Any questions regarding compatibility should be directed to our Office Services Department at +1.703.836.6620.

(BDSM 05/01)

*late no est.*Attorney's Docket No. *09/1309* <sup>Patent</sup> 032326-052

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of )

Stephane AYALA et al. )

Application No.: 09/545,288 ✓ )

Filed: April 7, 2000 )

For: METHOD FOR MAKING SMART )  
CARDS CAPABLE OF OPERATING )  
WITH AND WITHOUT CONTACT )

Group Art Unit: 3729

Examiner: M. Trinh

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RESPONSEAssistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

In response to the Office Communication dated October 1, 2001, Applicants respectfully request reconsideration and withdrawal of the restriction requirement, on the grounds that it is incomplete and/or improper.

The basic requirement for a proper restriction between inventions is that the inventions must be independent or distinct as claimed. 35 U.S.C. § 121; MPEP § 803.

The initial burden is on the Examiner to meet this requirement. Specifically, MPEP § 816 states:

The particular reasons relied upon by the Examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate.

In the present case, the Office Communication does not even set forth a conclusion, let alone any reasons that would support the restriction requirement. Since there has been no effort to show independence or distinctness between claimed inventions, the Office

*11-27-01 CES*

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Communication fails to meet both the standards set forth by the Patent and Trademark Office and the requirements of the statute, and therefore should be withdrawn as improper.

In addition, the MPEP sets forth a second criterion for a proper restriction requirement, namely that there must be a serious burden on the Examiner. For purposes of this criterion, the Manual states that a *prima facie* case may be made "if the Examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search..." Again, the Office Communication contains no such showing, and therefore fails to meet the second criterion for a proper restriction requirement. For this additional reason, therefore, the requirement should be withdrawn.

Although the restriction requirement is being traversed for the reasons set forth above, in order that this response be considered to be complete, the following provisional elections are being made:

**GROUP I:**

Applicants provisionally elect the species of Figures 1 and 3. The claims readable upon this species include claims 1, 2 and 4-30, with claims 1, 4-23 and 25-30 being generic to both species of this group.

**GROUP II:**

Applicants provisionally elect the species of Figures 5A-5C. The claims readable upon this species include claims 1-4, 6-24, 27 and 29, with claims 1-3, 6-23, 27 and 29 being generic to both of the species in this group.

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**GROUP III:**

Applicants provisionally elect Species 3A. The claims readable upon this species include claims 1-16 and 19-30, with claims 1-14 and 21-30 being generic to both species of this group.

**GROUP IV:**

Applicants provisionally elect Species 4D. The claims readable upon this species include claims 1-13, 23-25 and 30, with claims 1-13, 24 and 25 being generic to more than one of the species in this group.

Reconsideration and withdrawal of the restriction requirement is respectfully requested, on the grounds that it does not meet either of the two established criteria for insisting upon restriction. In the event that the requirement is repeated, or a new one is instituted, it is respectfully requested that the Examiner comply with the standards set forth in the MPEP, and explain the reasons for requiring the restriction.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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By: \_\_\_\_\_

  
James A. LaBarre  
Registration No. 28,632

Date: November 27, 2001

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TECHNOLOGY CENTER R3700

Filing Date: April 7, 2000Date: November 27, 2001App'n. No.: 09/545,288Work Atty.: JALaBarreInventor: Stephane AYALA et alDocket No.: 032326-057

The following was/were received in the U.S. Patent and Trademark Office on the date stamped hereon:

☒ Response

☐ Preliminary Amendment

☐ Reply Transmittal Letter

☐ Petition for \_ Month Extension of Time

☐ Submission of Formal Drawings w/\_ sheet(s) of drawings (Fig(s). 1-\_)

☐ Request for Approval of Drawing Changes w/\_ sheet(s) of red ink drawings

☐ Notice of Appeal

☐ Brief for Appellant

☐ Request for Oral Hearing

☐ Reply Brief

☐ Response to Restriction Requirement or Election of Species

☐ Terminal Disclaimer ☐ Certificate Under 37 C.F.R. § 3.73(b)

☐ Transmittal Letter for Missing Parts of Application

☐ Executed Declaration/Power of Attorney

☐ Assignment/Assignment Recordation Form Cover Sheet (PTO-1595)

☐ Claim for Convention Priority w/\_ certified copy(s)

☐ Information Disclosure Statement w/\_ document(s)

☐ Information Disclosure Citation (PTO-1449)

☐ Information Disclosure Statement Transmittal Letter

☐ Request for Corrected Notice of Recordation of Assignment w/copy of Notice

☐ Request for Continued Examination

☐ Check for \$ \_ is enclosed

☐ Check for \$ \_ is enclosed

☐ Charge \$ \_ to Deposit Account

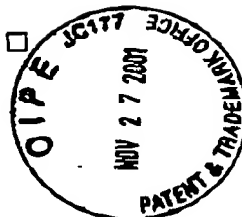
☐ Issue Fee Transmittal

☐ Payment of Issue Fee and Authorization to charge Deposit Account

☐ Request for Refund

☐ Status Inquiry

☐ Request for Corrected Filing Receipt w/copy of Official Filing Receipt

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